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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,888	02/20/2004	Joseph J. Kubler	14364US13	6967
23446	7590	10/21/2008	EXAMINER	
MCANDREWS HELD & MALLOY, LTD			AFSHAR, KAMRAN	
500 WEST MADISON STREET			ART UNIT	PAPER NUMBER
SUITE 3400			2617	
CHICAGO, IL 60661				

  

MAIL DATE	DELIVERY MODE
10/21/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/783,888	KUBLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KAMRAN AFSHAR	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 August 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 22-150 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 22-150 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date See Continuation Sheet.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/05/06, 06/23/06, 10/23/06, 11/16/06, 08/23/07, 07/21/08.

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 22-150 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6, 961, 312 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations recited in the present application are transparently found in the U.S. Patent No. 6, 961, 312 B2 with obvious wording variations. Take an example of comparing claim 22 of pending application and claims 1, 11, and 16 of the U.S. Patent No. 6, 961, 312 B2:

Pending Application 10/783,888	U.S. Patent No. 6, 961, 312 B2
22. A method for operating a communication system, the method comprising: receiving via a <u>wireless packet communication link</u> a message requesting setup	1. A call routing device comprising: interface circuitry for the exchange of signals with a <u>first telephony device</u> , the interface circuitry capable of receiving from the first telephony

<p><u>of a voice call</u>, the message comprising a <u>destination address</u>; identifying one of the at least one <u>communication link</u> based upon at least one of the <u>destination address and predetermined routing information</u>; sending via the identified one of the at least one <u>communication link signals requesting setup of the voice call</u>; receiving via the identified one of the at least one <u>communication link signals</u> representing call status; and establishing voice communication between the <u>wireless packet communication link</u> and the identified one of the at least one <u>communication link</u>, if <u>call status indicating establishment of a connection is received</u>.</p>	<p><u>device both voice and non- voice signals</u>; a host device communicatively coupled to the interface circuitry; at least one network interface capable of communicating via at least one of a <u>conventional switched telephone network and a packet network</u>, the at least one network interface communicatively coupled to the host device; and the host device having stored thereon <u>operational software and a database</u>, the database having at least one entry comprising <u>predefined call routing information and at least one associated destination address</u>, the <u>database for use in the routing of voice calls from the first telephony device to a second telephony device</u>, via the at least one network interface.</p>
<p>32. The device of claim 22 <u>wherein the operational software is at least capable of: receiving a voice call setup request from the first telephony device, the request comprising a destination address; identifying predefined call route information in the database, using at least the destination address; automatically establishing voice communication between the first telephony device and a second telephony device using the predefined call route information, if predefined call route information is identified; and requesting call route information from a user of the first telephony device, if predefined call route information is not identified.</u></p>	<p>11. The device of claim 1 <u>wherein the operational software is at least capable of: receiving a voice call setup request from the first telephony device, the request comprising a destination address; identifying predefined call route information in the database, using at least the destination address; automatically establishing voice communication between the first telephony device and a second telephony device using the predefined call route information, if predefined call route information is identified; and requesting call route information from a user of the first telephony device, if predefined call route information is not identified.</u></p>
	<p>16. The device of claim 11 <u>wherein the automatically establishing comprises: establishing a packet network connection via at least one of a premises network and a local area network for the exchange of packetized voice, if the identified predefined call routing information indicates routing of the call via an internal route.</u></p>

The claims of the U.S. Patent No. 6, 961, 312 B2 encompass the same subject matter except the instant “**A method for operating a communication system, the method comprising: receiving via a wireless packet communication link a message requesting setup of a voice call**” whereas the U.S. Patent No. 6, 961, 312 B2 claims are to “**A call routing device comprising: interface circuitry for the exchange of signals with a first telephony device, the interface circuitry capable of receiving from the first telephony device both voice and non- voice signals**”. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to implement the U.S. Patent No. 6, 961, 312 B2 “**A call routing device comprising: interface circuitry for the exchange of signals with a first telephony device, the interface circuitry capable of receiving from the first telephony device both voice and non- voice signals**” as a “**A method for operating a communication system, the method comprising: receiving via a wireless packet communication link a message requesting setup of a voice call**” because it was notoriously well known to utilize method and or a system i.e. inter-connecting a mobile end system to a communication network that includes a packet data network and a telephone network, using various (or suitable) interface devices to communicate packet data between the mobile end system and the packet data network, and to connect switched circuits between the mobile end system and the telephone network. Suitable interface devices may include a cellular telephone, a packet data cellular module, a telephone interface, and a local area network interface, among others. Each mobile end system will be identified by an address within the packet data network, and optionally by an address within the telephone network. Packet switches will receive data packets from various communication links, and route these data packets to mobile end systems, to fixed end systems, to external network gateways, or mobile network support elements including mobile location registers and routers and call setup. Data packets will include the address of the mobile end system or fixed end system to which the data packet is to be delivered.

Further, the instant claims obviously encompass the claimed invention of U.S. Patent No. 6, 961, 312 B2 and differ only in terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of U.S. Patent No. 6, 961, 312 B2, in re Goodman 29 USPQ 2d 2010

CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

3. Claims 22-150 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 22-89 filed on 08/26/2008 of co-pending application 10/801,472. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations recited in the present application are transparently found in the co-pending application 10/801,472 with obvious wording variations. Take an example of comparing claim 74 of pending application and amended claim 22 of the co-pending application 10/801,472:

Pending Application 10/783,888	Co-pending Application 10/801,472
74. A system supporting voice communication comprising: at least one processor capable of receiving via a <u>wireless packet communication link</u> at least one <u>message requesting setup of a voice call</u> , the at least one message comprising a destination address; the at least one <u>processor capable of identifying a type</u> of the destination address; the at least one processor capable of establishing voice communication between the <u>wireless packet communication link</u> and at least one <u>wired communication link</u> based upon at least one of a value of the destination address, the identified type of the destination address, and a <u>cost of use of the at least one wired communication link</u> ; and the at least one <u>processor capable of sending via the wireless packet communication link an indication of a call connected condition</u> .	Claim 22. (Currently amended) A multi-mode communication device comprising: a first receiver and transmitter for communicating via a first wireless communication network; a second receiver and transmitter for communicating via a second wireless communication network; at least one <u>processor</u> communicatively coupled to the first receiver and transmitter and the second receiver and transmitter, the at least one <u>processor capable of establishing the exchange of information via at least, one of the first wireless communication network and the second wireless communication network</u> ; and wherein the at least one <u>processor evaluates a cost of use of a communication network and establishes the exchange of information based upon the cost</u> .

The claims of the co-pending application 10/801,472 encompass the same subject matter except the instant "**A system supporting voice communication**" whereas the co-pending application 10/801,472 claims are to "**A multi-mode communication device**". Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to implement the co-pending application 10/801,472 "**A multi-mode communication device**" as a "**A multi-mode communication device**" because it was notoriously well known to utilize method and or a system i.e. inter-connecting a mobile end system to a communication network that includes a packet data network and a telephone network, using various (or suitable) interface devices to communicate packet data between the mobile end system and the packet data network, and to connect switched circuits between the mobile end system and the telephone network. Suitable interface devices may include a cellular telephone, a packet data cellular module, a telephone interface, and a local area network interface, among others. Each mobile end system will be identified by an address within the packet data network, and optionally by an address within the telephone network. Packet switches will receive data packets from various communication links, and route these data packets to mobile end systems, to fixed end systems, to external network gateways, or mobile network support elements including mobile location registers and routers and call setup. Data packets will include the address of the mobile end system or fixed end system to which the data packet is to be delivered and or assigning cost units to the various communication links, comparisons between factors such as actual monetary costs, bandwidths, delays, loading and power consumption are taken into consideration.

Further, the instant claims obviously encompass the claimed invention of co-pending application 10/801,472 and differ only in terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of co-pending application 10/801,472, in re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

***Allowable Subject Matter***

4. Upon filing a suitable Terminal Disclaimer and proper overcome of the ***Double Patenting rejection*** as discussed above in items 1-3, Claim22-150 would be allowed.

With respect to claim 1, Sharman (H1641) is the closest prior art to the application invention which discloses a method for operating a communication system, the method comprising: receiving via a wireless packet communication link a message requesting setup of a voice call (See Sherman e.g. 906 of Fig. 9, Co. 1, Lines 33-44, Figs. 1-9). However, the prior art of record fails to disclose singly or in combination or render obvious that the message comprising a destination address; identifying one of at least one communication link based upon at least one of the destination address and predetermined routing information; sending via the identified one of the at least one communication link signals requesting setup of the voice call; receiving via the identified one of the at least one communication link signals representing call status; and establishing voice communication between the wireless packet communication link and the identified one of the at least one communication link, if call status indicating establishment of a connection is received.

With respect to claim 45, the prior art of record fails to disclose singly or in combination or render obvious that the method comprising: receiving via one of at least one communication link an indication of an incoming voice call, each of the at least one communication link having an associated type; sending via a wireless packet communication link a message requesting setup of the voice call; receiving via the wireless packet communication link a message indicating call status; and establishing voice communication between the wireless packet communication link and the one of the at least one communication link based upon the associated type, if call status indicating establishment of a connection is received.

With respect to claim 61, the prior art of record fails to disclose singly or in combination or render obvious that the method comprising: receiving via a wireless packet communication link at least one message requesting setup of a voice call, the at least one message comprising a destination address; identifying a type of the destination address; establishing voice communication between the wireless

packet communication link and at least one wired communication link based upon at least one of a value of the destination address, the identified type of the destination address, and a cost of use of the at least one wired communication link; and sending via the wireless packet communication link an indication of a call connected condition.

With respect to claim 74, the prior art of record fails to disclose singly or in combination or render obvious that the at least one message comprising a destination address; the at least one processor capable of identifying a type of the destination address; the at least one processor capable of establishing voice communication between the wireless packet communication link and at least one wired communication link based upon at least one of a value of the destination address, the identified type of the destination address, and a cost of use of the at least one wired communication link; and the at least one processor capable of sending via the wireless packet communication link an indication of a call connected condition.

With respect to claim 87, the prior art of record fails to disclose singly or in combination or render obvious that the message requesting setup of a voice call comprises a destination address and information to cause the communication system to, at least: identify one of at least one communication link based upon at least one of the destination address and predetermined routing information; send via the identified one of the at least one communication link one or more signals requesting setup of the voice call; receive via the identified one of the at least one communication link one or more signals representing call status; and establish voice communication between the wireless packet communication link and the identified one of the at least one communication link, if call status indicating establishment of a connection is received.

With respect to claim 100, the prior art of record fails to disclose singly or in combination or render obvious that the message requesting setup of a voice call comprises: a destination address and information to cause the communication system to, at least: identify one of at least one communication link based upon at least one of the destination address and predetermined routing information; send via the identified one of the at least one communication link one or more signals requesting setup of the voice

call; receive via the identified one of the at least one communication link one or more signals representing call status; and establish voice communication between the wireless packet communication link and the identified one of the at least one communication link, if call status indicating establishment of a connection is received.

With respect to claim 114, the prior art of record fails to disclose singly or in combination or render obvious that a message requesting setup of a voice call, the voice call corresponding to an indication received by the communication system via one of at least one communication link having an associated type; and sending to the communication system via the wireless packet communication link a message indicating call status, where the message indicating call status comprises information to cause the communication system to establish voice communication between the wireless packet communication link and the one of the at least one communication link based upon the associated type of the one of the at least one communication link.

With respect to claim 123, the prior art of record fails to disclose singly or in combination or render obvious that a message requesting setup of a voice call, the voice call corresponding to an indication received by the communication system via one of at least one communication link having an associated type; and send to the communication system via the wireless packet communication link a message indicating call status, where the message indicating call status comprises information to cause the communication system to establish voice communication between the wireless packet communication link and the one of the at least one communication link based upon the associated type of the one of the at least one communication link.

With respect to claim 134, the prior art of record fails to disclose singly or in combination or render obvious that the at least one message requesting setup of a voice call comprises a destination address and information to cause the communication system to, at least: identify a type of the destination address; establish voice communication between the wireless packet communication link and at least one wired communication link based upon at least one of: a value of the destination address, the identified type of the destination address, and a cost of use of the at least one wired communication link; and send

via the wireless packet communication link a message comprising an indication of a call connected condition; and receiving the message comprising an indication of a call connected condition via the wireless packet communication link from the communication system.

With respect to claim 142, the prior art of record fails to disclose singly or in combination or render obvious that the at least one message requesting setup of a voice call comprises a destination address and information to cause the communication system to, at least: identify a type of the destination address; establish voice communication between the wireless packet communication link and at least one wired communication link based upon at least one of a value of the destination address, the identified type of the destination address, and a cost of use of the at least one wired communication link; and send via the wireless packet communication link a message comprising an indication of a call connected condition; and receive the message comprising an indication of a call connected condition via the wireless packet communication link from the communication system.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (571) 272-7796. The examiner can be reached on Monday-Friday.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, **Eng, George** can be reached @ (571) 272-7495. The fax number for the organization where this application or proceeding is assigned is **571-273-8300** for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kamran Afshar/

Examiner, Art Unit 2617